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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,197	03/06/2000	David Page	109140-0002	8386

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CESARI AND MCKENNA, LLP
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BOSTON, MA 02210

EXAMINER

O CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627
DATE MAILED: 01/24/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/519,197	Applicant(s) Page et al.
	Examiner O'Connor	Art Unit 3627
		
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>three</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p>		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>July 19, 2002 (Amdt "A") and November 6, 2002 (Election)</u> .		
2a) <input checked="" type="checkbox"/> This action is FINAL . 2b) <input type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>1-25</u> is/are pending in the application.		
4a) Of the above, claim(s) <u>1-7 and 15-25</u> is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input checked="" type="checkbox"/> Claim(s) <u>8-14</u> is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>March 6, 2000</u> is/are a) <input type="checkbox"/> accepted or b) <input checked="" type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).		
11) <input checked="" type="checkbox"/> The proposed drawing correction filed on <u>July 19, 2002</u> is: a) <input checked="" type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. §§ 119 and 120		
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).		
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
*See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.		
15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.		
Attachment(s)		
1) <input type="checkbox"/> Notice of References Cited (PTO-892)		
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
6) <input type="checkbox"/> Other: _____		

Art Unit: 3627

DETAILED ACTION

Preliminary Remarks

1. This Office action has been prepared in response to the amendment and arguments filed by applicant on July 19, 2002 (Paper № 7), and the response to restriction requirement filed by applicant on November 6, 2002 (Paper № 9).

2. The amendment of claims 1, 8, 15, and 19 by applicant in Paper № 7 is hereby acknowledged.

Election/Restriction

3. Applicant's election with traverse of Invention II (Claims 8-14) in Paper № 9 is hereby acknowledged.

The traversal is on the ground(s) that Invention II is not patentably distinct from Inventions III and IV for the reasons set forth by the examiner, because the apparatus of Invention II requires a GUI, and “displaying *any* text on the GUI qualifies as a ‘web page’ ” (emphasis added).

Furthermore, applicant argues, Invention II is not patentably distinct from Invention I for the reasons set forth by the examiner, because “the additional element of adding a reward [to the apparatus of Invention I, relative to the apparatus of Invention II] is not a separate utility it is a separate detail, much like the genus-species relationship.”

Art Unit: 3627

Regarding the first argument, *any* text displayed in the GUI would not *necessarily* comprise a web page. A web page is an electronic document viewed via the world-wide-web, hence the name, *web-page*. While it is true that every web page can only be viewed by using some sort of GUI, *not* everything viewed in *any* GUI is *necessarily* a web page.

Regarding the second argument, while a combination-subcombination is indeed somewhat similar to a genus-species relationship, the inventions are, nevertheless, distinct if it can be shown that: (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, *and* (2) that the subcombination has utility by itself or in other combinations (See MPEP § 806.05(c)). In this case, the combination as claimed does not require the particulars of the subcombination as claimed, because a system in accordance with Invention I need not include the user designating the order from a list of products as required by Invention II. The subcombination has separate utility, such as for use with ordering systems that do not offer any rewards.

4. The restriction requirement is still deemed proper and is therefore made FINAL.

5. Claims 1-7 and 15-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in Paper N° 9.

Art Unit: 3627

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the identity of the user, the plurality of contacts, the contact information, the graphical user interface, the web page provided by the server, the order designated and entered via the graphical user interface, the list of products accessed via the graphical user interface, the message pertaining to the order, the instructions, the address facilitating access to the list, the credit entries, and the user's database record, must all be shown or the features cancelled from the claims. No new matter should be entered.

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawings. MPEP § 608.02(d).

7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. No new matter should be entered.

Claim Rejections - 35 USC § 112, Second Paragraph

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 9 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because the following recitations, found therein, lack a sufficient antecedent basis:

- In claim 9, line 2: “the at least one designated contact”;
- In claim 9, line 2: “the item”;
- In claim 11, lines 1-2: “the instructions”;
- In claim 12, line 2: “the instructions”;
- In claim 13, line 3: “the at least one designated contact”; and,
- In claim 14, lines 2-3: “the user’s database record”.

Art Unit: 3627

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 8 and 10-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Harrington (US 5,895,454).

Harrington discloses an electronic commerce system for communicating with a user 27 via a client machine 11 connected to a global computer network 35, the system comprising: a server connected to the global computer network; a database 10, accessible to the server, storing the identity of the user, a plurality of contacts 12 designated by the user, and contact information facilitating communication with the contacts 12; a graphical user interface 13 suitable for displaying a web page 24 provided by the server, the graphical user interface attached to the client machine; an order designated and entered via the graphical user interface, the order designating at least one product 36 from a list of products 32 accessed via the graphical user interface; a message 34 pertaining to the order and entered via the graphical user interface for transmitting to at least

Art Unit: 3627

one of the designated contacts 25; and, wherein the server transmits the message 29 to the at least one contact 25.

Regarding claim 10, the list of products 32 in the system of Harrington comprises goods, services, or goods and services (see, for example, column 4, line 9, and column 5, lines 2-3).

Regarding claim 11, the list of products 32 in the system of Harrington is embedded in the instructions (i.e. electronic format--see, for example, column 5, line 6).

Regarding claim 12, the list of products 32 in the system of Harrington is stored in a computer accessible over the network, the instructions comprising an address facilitating access to the list by the client computer (see, for example, column 4, line 12).

Regarding claim 13, the client machine in the system of Harrington is configured to display the interface and to transmit to the server the list of products 32, the at least one designated contact 25, and the message 34.

Regarding claim 14, the server in the system of Harrington is further configured to process orders for products, the server checking for credit entries in the user's database record when processing an order from the user and to adjust 26 the order based on any located entries.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3627

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as unpatentable over Harrington (US 5,895,454), in view of Kanter (US 5,537,314).

Harrington shows an electronic commerce system comprising a server, a database, and client computers, operating over the Internet, wherein customers can view from the database the goods and/or services offered for sale by various vendors/suppliers, and place orders to purchase those goods and/or services, as applied above in the rejection of claims 8 and 10-14, under 35 U.S.C. 102(a), but the system of Harrington fails to include a referral recognition system to offer incentives to customers in exchange for successful referrals/recommendations.

However, Kanter discloses a referral recognition system where customers are offered incentives/rewards in order to transmit messages to contacts encouraging the contacts to also make the same purchases, and the system of Kanter monitors the contacts to determine if the contact then makes a purchase, in order to credit the original purchaser with the promised reward.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Harrington so as to include a referral recognition system for an incentive reward program, in accordance with the teachings of Kanter, in order to generate increased sales by incentivizing the customers to act as sales agents by making recommendations to contacts to purchase the goods and/or services.

Art Unit: 3627

Response to Arguments

14. Applicant's arguments filed July 19, 2002 have been fully considered but they are not persuasive.

15. Regarding the argument that the messages sent to the designated contacts in the system of Harrington are not sent, "with the hope that the message may prompt the contacts to purchase a product," it is noted that the features upon which applicant relies (i.e., hoping for a particular result/outcome) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

16. Regarding the argument that the system of Kanter discloses, "no suggestion that the customers send personal or other such messages to their contacts to prompt their buying," it is noted that the features upon which applicant relies (i.e., sending of personal or other such messages to prompt their buying) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 3627

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to the disclosure.

18. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

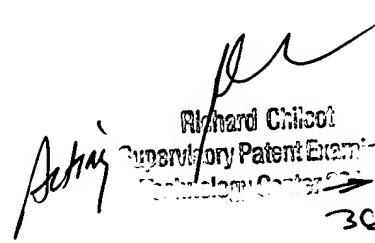
19. PLEASE TAKE NOTICE that the Technology Center and Group Art Unit numbers for prosecution of this application have been changed. The new Technology Center number is 3600. The new Group Art Unit number is 3627.

Art Unit: 3627

20. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

GJOC

January 13, 2003


Richard Chilcot
Supervisory Patent Examiner
Technology Center 2222
 3627